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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/838,341      | 04/20/2001  | Takahiro Hayashi     | Q64162              | 1065             |

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SUGHRUE, MION, ZINN, MCPEAK & SEAS  
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Washington, DC 20037

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| EXAMINER |
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RUHL, DENNIS WILLIAM

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| ART UNIT | PAPER NUMBER |
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3629

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05/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                 |                |  |
|------------------------------|-----------------|----------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |  |
|                              | 09/838,341      | HAYASHI ET AL. |  |
| Examiner                     | Art Unit        |                |  |
| Dennis Ruhl                  | 3629            |                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 March 2007.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 35 and 36 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 35,36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/07 has been entered. Currently claims 35,36 are pending. The examiner will address applicant's arguments at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35,36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 35 it is not clear as to what the scope of the limitation of "control means" is. The claim recites "control means for making said transmission means transmit said current location information in order to receive the delivery information including.....at the alighting place, and for making transmission by said transmission means complete before putting a new customer on board". The language of "*in order to receive the delivery information including.....at the alighting place*" is reciting nothing more than the intended future result of the transmission step. This is language that is not defining any further structure but is reciting the reason that the transmission is being made. The language "*and for making transmission by said transmission means*

*complete before putting a new customer on board*" is indefinite. What is the structure that is covered by this language? It is not clear from reading the specification what the corresponding structure is that is covered by this language. One wishing to avoid infringement would not know what is covered by this language. What structure is disclosed that makes the transmission complete before putting a new customer on board? What if a new customer enters the taxi as another one is exiting, as frequently happens at a busy place like an airport or a subway or train station terminal? What is the structure from the specification that could stop a customer from getting on board, unless the transmission has been completed? This is not clear.

Also still remaining as an issue is the following from the last office action:

For claim 35, from the specification on page 40, it is disclosed that the driver of the transportation vehicle presses a button to enable and disable the operation of the transmission means. The examiner is not clear as to whether or not the "control means" includes the driver who presses the button or if the "control means" is the button itself. The button is not capable of enabling or disabling the transmission means by itself, and this leads the examiner to believe that the "control means" includes the driver; however, from a structural standpoint and knowing that under 35 USC 101 a person cannot be claimed as part of the scope of an apparatus claim, the examiner also feels that one could reasonably interpret the "control means" to be the button that is pressed by the driver. What is the disclosed structure from the specification that is covered by the language "control means"? This is not clear.

From the standpoint of a prior art examination, the examiner has interpreted and assumed the language "control means" to be only the disclosed button, as the other interpretation (that the control means is the driver) renders the claim as non-statutory. This interpretation is done in view of the indefiniteness of the claims as they are best understood by the examiner.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 35,36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (6430496).

For claim 35, Smith discloses a transportation system where transportation vehicles 20 are dispatched to pick up either passengers or cargo. The mandatory

terminals are located in the vehicles and are disclosed as having a transmission means, which is the communication link 22 and associated hardware/software that allows the current location information to be transmitted to the order server 10. Also see column 24, lines 47-57. See column 22, lines 5-8 where it is disclosed that to determine if a vehicle is en route, a comparison is made between two recent position readings. This is a disclosure of "periodic" transmission of location information as claimed. The means for receiving delivery information from the server can be interpreted to be the communication link 22 (that allows for the receipt of order information) or can be interpreted as the communication process 24 and associated hardware that allow the mandatory terminals to receive order information. The plurality of ordering terminals for placing an order are satisfied by the "remote data entry terminals" disclosed in column 4, lines 61-64 or are satisfied by column 4, line 65 to column 5, line 7. The means for transmitting the order information to the server is the telephone line 15 that is used to send the order information from the remote terminals to the order server 10. The order server has means for receiving the current location information of a vehicle and for specifying current location as claimed. The AVL system 18 tracks and determines the location of vehicles as claimed. Also see column 6, lines 36-41. The order server is disclosed as receiving location information from the individual vehicles so that automated dispatching can occur in an efficient manner. The means for receiving the order information is the telephone line 15 that allows the order server to receive information concerning the transportation order. The means for specifying the closest vehicle is satisfied by the fact that Smith discloses a "closest vehicle request", see

column 8, line 21 and column 13k lines 44,45. The server has means for transmitting, which is the communication process 24 and the associated hardware/software that controls the communications to the vehicles. Smith discloses that information such as start information and completion information are transmitted as claimed. See column 17, lines 30-48. Not specifically disclosed is the claimed "control means". For purposes of examination and as best understood by the examiner, *after consulting the specification for guidance on what structure is covered by the "control means" language*, the examiner has interpreted the "control means" to be a button that enables or disables the transmission means. This is what the examiner would interpret as an on/off button. One of ordinary skill in the art would take notice of the fact that if the mandatory terminals and their associated electronics of the transportation vehicle 20 are continuously left powered on, one would expect the batteries to run down. In view of this fact, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide an on/off button, so that the navigational equipment, communication equipment and other electronics in the transportation vehicle can be turned off and on so as to not run down the vehicle battery. Applicant has disclosed a button that is pressed by the driver to either enable (on) or disable (off) the transmission means. This is the same as an on/off button that would have been obvious to one of ordinary skill in the art. The on/off button allows one to enable or disable the transmission of location information in any time period desired, which satisfies what is claimed.

For claim 36, nothing further is recited about the “transportation system” so the claim is satisfied by Smith. The location of the business that intends to use the recited system has nothing to do structurally with the system itself. The location of the business is not part of the transportation system so this is claiming nothing further to that recited in claim 35.

6. Applicant's arguments filed 3/6/07 have been fully considered but they are not persuasive.

Applicant has stated that after dropping off a customer, before picking up another one, a taxi merely drives around looking for another fare. Where is the support for this assumption? In Smith, which is the prior art being used to reject the claims, the taxis do not merely drive around aimlessly. They receive guidance and directions on where to pick up their new fares so that the overall system efficiency of vehicle dispatching can be increased. This statement made by applicant is not addressing the closest prior art of record, which is Smith, so the statement is noted but is not seen as relevant to the issues at hand. Applicant must compare the closest prior art when addressing the novelty of the claims.

Applicant has argued that “Smith fails to teach or suggest sending current location information while a vehicle is not carrying a customer, in order to receive a request for transportation of a load.”. This is arguing that the apparatus claims should be allowed based on a method recitation of doing a step, as if the presently pending claims were method claims. This is not persuasive. Additionally, as best understood by

the examiner from the guidance given in the specification, the control means is a button (on/off). This has been addressed in the rejection of record. Applicant has not stated for the record what structure is covered by the newly amended language of "control means" and due to this, it is not clear why applicant thinks that this limitation is novel. What structure does this language cover? The prior art of Smith transmits location information to a central server, and this satisfies the claimed function of the control means making the transmission means transmit the current location information. As stated previously in this office action, the language of "*in order to receive the delivery information including.....at the alighting place*" is reciting nothing more than the intended future result of the transmission step. This is language that is not defining any further structure but is reciting the reason that the transmission is being made. Concerning the portion of the control means that makes the transmission complete before putting on a new customer, the structure covered by this language is not clear and is indefinite.

The arguments are not persuasive.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL  
PRIMARY EXAMINER